

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN TEXTER,
ARTHUR H. HERZ
and
HENRY W. ALTLAND

Appeal No. 95-2765
Application 08/025,474¹

HEARD: November 12, 1997

Before JOHN D. SMITH, WEIFFENBACH and OWENS, *Administrative
Patent Judges.*

¹ Application for patent filed March 3, 1993. According to appellants, the application is a continuation-in-part of Application 07/763,029, filed September 20, 1991, abandoned.

Appeal No. 95-2765
Application 08/025,474

JOHN D. SMITH, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-14 and 16-25.

The subject matter on appeal is directed to a method (claims 1-11 and 18-25) of accelerating black and white development of negative-type silver halide photographic materials by contacting the materials, after exposure to an image, with a developer prebath or developer bath comprising a triazolium thiolate accelerator compound as defined in formula (I) in the claims. Composition claims 12-14, 16, and 17 comprising aqueous solutions of the bath or prebath are also presented in this appeal.

Copies of representative method claim 1 and composition claim 12 are reproduced in an attached appendix.

The references of record relied upon by the examiner are:

Altland et al. (Altland)	4,378,424	Mar. 29, 1983
Kojima et al. (Kojima)	5,037,726	Aug. 6, 1991

The appealed claims stand rejected for obviousness

Appeal No. 95-2765
Application 08/025,474

(35 U.S.C. § 103) in view of Kojima. Additionally, composition claims 12-14, 16, and 17 stand rejected under the same section of this statute in view of Altland.

We affirm the examiner's rejection of composition claims 12-14, 16, and 17 in view of Kojima. We reverse all other rejections.

THE REJECTION OF THE COMPOSITION CLAIMS IN VIEW OF KOJIMA

The claimed composition is directed to a developer prebath or developer bath which comprises an aqueous solution of a triazolium thiolate accelerator compound in an amount between 10^{-8} and 10^{-3} moles/L. The bath does not contain any iron (III) ion complex salt having bleaching activity or any nucleating agent capable of chemically fogging a negative-type silver halide emulsion. Appealed claim 12 also includes the language that the "development comprises developing agent selected from the group consisting of dihydroxybenzenes 3-pyrazolidones, and amino-phenols" which language, according to appellants, unequivocally indicates that the developer baths of the claim comprise the recited developing agents. See the Reply Brief at page 9. It is reasonably clear, however, that such claim language does not require that the developer *prebaths* contain the recited

developing agents. It is also important to note, at the outset, that the claimed baths are to be used for black-and-white development of a negative-type silver halide photographic element.

Kojima discloses developer baths and developer prebaths for the development of a direct positive image, not for the development of a negative-type silver halide photographic element as claimed. However, the discovery of a new use of a previously known composition, even when that use is unobvious from the prior art, cannot impart patentability to claims to the known composition. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

Although Kojima does not disclose a working example of either a developer bath or developer prebath solution, Kojima expressly teaches that triazolium thiolate compounds, as claimed herein, may be incorporated into developer solutions and/or a prebath therefor preferably in an amount of from 1×10^{-8} to 1×10^{-3} moles/L as nucleation accelerators. See Kojima at column 13, line 58, to column 14, line 4. We recognize that the appealed claims exclude any nucleating agent capable of chemically fogging a negative-type silver halide emulsion, and

that Kojima may use a nucleating agent, as described at column 17, line 1, to column 19, line 40, in a "chemical fogging method" by incorporation of the nucleating agent into a developer bath or prebath (column 16, lines 44-49). However, Kojima preferably incorporates the nucleating agent into the light-sensitive material, not the bath or prebath, when "chemical fogging" (column 16, line 49), and Kojima apparently requires no nucleating agent in the developer bath or prebath when following an "optical fogging method" (column 15, line 58, to column 16, line 2, and Kojima claim 16). Accordingly, we agree with the examiner that Kojima suggests the use of a developer prebath or developer bath that does not contain a nucleating agent capable of chemically fogging a negative-type silver halide emulsion.

With respect to the negative limitation in the appealed composition claim that the developer prebath or developer bath does not contain any iron (III) ion complex salt having bleaching activity, Kojima teaches that bleaching agents such as Fe(III) are preferably used in a separate bleaching step by incorporation into a bleaching bath or bleaching prebath. See Kojima at column 24, lines 4-63. Accordingly, for Kojima's purposes, i.e., the development of black and white direct-positive photographic materials, bleaching agents are employed in separate compositions

Appeal No. 95-2765
Application 08/025,474

from the developer baths or developer prebaths. The disclosures of Kojima, discussed above, raise an inference of obviousness for the subject matter defined by the composition claims on appeal.

We have carefully considered each of the arguments advanced by appellants and each of the declarations made of record to support appellants' arguments in this appeal. However,

with respect to the rejection of the composition claims based on Kojima, we agree with the examiner that the evidence of obviousness outweighs the evidence of nonobviousness. Particularly, we are not convinced by the experimentation reported in the auxiliary declaration filed by John Texter on July 5, 1994 that the image forming method described by the United States Patent No. 5,037,726 to Kojima is inoperable. That specific developer prebaths labeled PB1 and PB2 (with and without a specific nucleation agent) obliterated the direct-positive image of a specific Eastman Kodak film does not satisfy appellants' burden of showing the inoperability of the Kojima patent (assigned to Fuji Photo Film Co., Ltd.).

Initially, we note that a patent is presumed valid (35 U.S.C. § 282), and this presumption of validity applies to a

patent's disclosure and each of its claims. *In re Spence*, 261 F.2d 244, 246, 120 USPQ 82, 83 (CCPA 1958). Thus, the effect of appellants' declaration is to invalidate method claims 13 and 14 of the Kojima patent which specifically recite the formation of a direct-positive image by using either a developing solution or a prebath. With respect to the experiments described in the declaration, it must be said that in a United States patent it is to be presumed that a process, if used by one skilled in the art, will produce the product alleged by the patentee and such presumption is not overcome by a mere showing that it is possible to operate within the disclosure (e.g., by using an Eastman Kodak film rather than a Fuji Photo film) without obtaining the desired product. *In re Michalek*, 162 F.2d 229, 231-32, 74 USPQ 107, 109 (CCPA 1947). Upon review of all the evidence of record, it is our judgment that appellants have not provided a sufficient quantum of evidence to establish that Kojima constitutes a nonenabling (inoperative) disclosure with respect to the process in question or that claims 13 and 14 of Kojima are invalid.

THE REJECTION OF THE METHOD CLAIMS OVER KOJIMA

Appeal No. 95-2765
Application 08/025,474

Appealed method claims 1-11 and 18-25 also stand rejected for obviousness in view of the disclosures of Kojima. We reverse this rejection.

As emphasized throughout the record, appellants' appealed method claims are directed to the development of a negative type silver halide photographic element. In contrast, Kojima's disclosure is directed exclusively to direct-positive image formation, direct-positive silver halide emulsions, and direct-positive developing and processing methods. Particularly see Kojima at column 23, lines 47-53.

As explained in the Texer declaration filed July 5, 1994 entitled "NEGATIVE/DIRECT-POSITIVE DECLARATION," negative-type silver halide emulsions are comprised of silver halide grains which principally form latent images at surface sites, since surfaces have the greatest concentration of defects suitable for latent image stabilization, for normal silver halide grains. Thus, when negative-type emulsions are exposed and developed, the predominant development is surface development. On the other hand, Texer explains in the declaration that direct-positive type silver halide emulsions are comprised of silver halide grains that principally form latent image at sites interior to the grain. Thus, Texer concludes that negative-

type emulsions and positive-type emulsions "are distinctly different and are used for different purposes." See the declaration at paragraph 6. This conclusion stands unrebutted by the examiner. Moreover, the examiner's statement in the Answer bridging pages 14 and 15 that a negative-type or direct-positive type silver halide element differs from each other in its final image, "not the element before processing" ignores the express language required by the method claim which is the development of a "negative-type silver halide photographic element. It is well settled that every limitation in a claim must be considered in

resolving the obviousness of a claimed invention as a whole within the meaning of 35 U.S.C. § 103. *In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974).

We also observe that no prior art reference has been cited disclosing the type or types of prior art developer pre-baths or developer baths which have been used for negative-type silver halide photographic elements. Nor has the examiner cited any evidence that the developer prebaths or developer baths used for development of a direct-positive silver halide photographic element may be used for the development of a negative type silver

halide photographic element as clearly recited in the method claims on appeal. Accordingly, the examiner has failed to establish a factual basis to support a legal conclusion that it would have been obvious within the meaning of 35 U.S.C. § 103 to use the Kojima developer prebaths or developer baths in a process or development of a negative-type silver halide photographic element. We, therefore, reverse the examiner's rejection of the appealed method claims based on the disclosures of Kojima.

THE REJECTION OF THE APPEALED COMPOSITION CLAIMS OVER ALTLAND

Appealed composition claims 12-14, 16, and 17 are also rejected under 35 U.S.C. § 103 over Altland. We also reverse this rejection.

Although Altland discloses aqueous compositions of triazolium thiolate, for Altland's purposes, such compositions are either used for fixing or stabilization. When used as a fixing composition (fixing bath), Altland describes a composition which contains 70×10^{-3} moles/L in triazolium thiolate concentration, i.e., a composition that contains 70 times the amount of triazolium thiolate than the amount defined by the appealed claims. Further, appellants have provided evidence in the declaration executed June 15, 1994 by Texter that a fixing

Appeal No. 95-2765
Application 08/025,474

bath with a triazolium thiolate concentration of 1.0×10^{-3} moles/L is inoperable as a fixing bath.

With respect to the examiner's assertion that Altland also describes the use of triazolium thiolate aqueous compositions for use as stabilizers, appellants point out that when used as a stabilizer, the triazolium thiولات are restricted to use for incorporation into the silver halide element. There is no factual support for the examiner's implied assertion that one would form a triazolium thiolate aqueous composition having a triazolium thiolate concentration in the range claimed for that purpose. Accordingly, we also reverse the examiner's separately stated rejection of the appealed composition claims for obviousness over Altland.

In summary, the examiner's rejection of the appealed composition claims over Kojima is affirmed. The examiner's rejection of the appealed method claims over Kojima is reversed. The examiner's rejection of the appealed composition claims over Altland is reversed. Accordingly, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Appeal No. 95-2765
Application 08/025,474

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CAMERON WEIFFENBACH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

Appeal No. 95-2765
Application 08/025,474

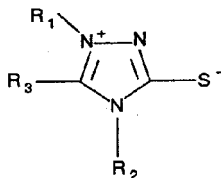
Joshua G. Levitt
Eastman Kodak Company
Patent Department
Rochester, NY 14650-2201

APPENDIX

1. A method of accelerating image formation during black and white development of a negative type silver halide photographic element comprising the steps of:

exposing said negative type silver halide photographic element to actinic radiation; and

contacting said negative-type silver halide photographic element during processing with a developer prebath or a developer bath comprising an accelerator compound of the formula:



wherein

R₁ is a substituted or unsubstituted alkyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted alkenyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted cycloalkyl group having from 3 to 28 carbon atoms, a substituted or unsubstituted aryl group having from 6 to 33 carbon atoms, an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group, connecting to a substituted or unsubstituted aryl group, having 6 to 33 carbon atoms, or an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group connecting to a substituted or unsubstituted heterocyclic ring containing two or more heteroatoms having 1 to 25 carbon atoms;

R₂ is a substituted or unsubstituted amine group having from 0 to 25 carbon atoms, a substituted or unsubstituted alkyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted alkenyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted cycloalkyl group from 3 to 28 carbon

atoms, a substituted or unsubstituted acyloxy group having from 2 to 25 carbon atoms, a substituted or unsubstituted alkoxy group

having from 1 to 28 carbon atoms, a substituted or unsubstituted aryl group having from 6 to 33 carbon atoms, a substituted or unsubstituted heterocyclic ring having from 1 to 28 carbon atoms and one or more hetero atoms, an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group, connecting to a substituted or unsubstituted aryl group, having 6 to 33 carbon atoms, or an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group connecting to a substituted or unsubstituted heterocyclic ring containing two or more hetero atoms having 1 to 25 carbon atoms;

R_3 is a substituted or unsubstituted amine group having from 0 to 25 carbon atoms, a substituted or unsubstituted alkyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted alkenyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted cycloalkyl group having from 3 to 28 carbon atoms, a substituted or unsubstituted acyloxy group having from 2 to 25 carbon atoms, a substituted or unsubstituted alkoxy group having from 1 to 28 carbon atoms, a substituted or unsubstituted aryl group having from 6 to 33 carbon atoms, a substituted or unsubstituted heterocyclic ring having from 1 to 28 carbon atoms and one or more hetero atoms, an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group, connecting to a substituted or unsubstituted aryl group, having 6 to 33 carbon atoms, or an alkyl, cycloalkyl, alkoxyalkyl, aryl, or phenoxy group connecting to a substituted or unsubstituted heterocyclic ring containing two or more hetero atoms;

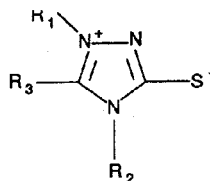
said R_1 , R_2 , and R_3 may further combine with each other to form a 5-, 6-, or 7-membered ring; and wherein

said developer prebath and developer bath do not contain any iron(III) ion complex salt having bleaching activity or any nucleating agent capable of chemically fogging a negative-type silver halide emulsion.

12. A bath selected from the group consisting of developer prebaths and developer baths for black-and-white

Appeal No. 95-2765
Application 08/025,474

development of a negative-type silver halide photographic element, wherein said development comprises developing agent selected from the group consisting of dihydroxybenzenes, 3-pyrazolidones, and aminophenols; and wherein said bath



comprises an
accelerator
formula:

aqueous solution of
compound of the

wherein

R_1 is a substituted or unsubstituted alkyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted alkenyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted cycloalkyl group having from 3 to 28 carbon atoms, a substituted or unsubstituted aryl group having from 6 to 33 carbon atoms, an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group, connecting to a substituted or unsubstituted aryl group, having 6 to 33 carbon atoms, or an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group connecting to a substituted or unsubstituted heterocyclic ring containing two or more heteroatoms having 1 to 25 carbon atoms;

R_2 is a substituted or unsubstituted amine group having from 0 to 25 carbon atoms, a substituted or unsubstituted alkyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted alkenyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted cycloalkyl group from 3 to 28 carbon

atoms, a substituted or unsubstituted acyloxy group having from 2 to 25 carbon atoms, a substituted or unsubstituted alkoxy group having from 1 to 28 carbon atoms, a substituted or unsubstituted aryl group having from 6 to 33 carbon atoms, a substituted or unsubstituted heterocyclic ring having from 1 to 28 carbon atoms and one or more hetero atoms, an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group, connecting to a substituted or unsubstituted aryl group, having 6 to 33 carbon atoms, or an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group connecting to a substituted or unsubstituted heterocyclic ring containing two or more hetero atoms having 1 to 25 carbon atoms;

R_3 is a substituted or unsubstituted amine group having from 0 to 25 carbon atoms, a substituted or unsubstituted alkyl group having from 1 to 28 carbon atoms, a substituted or unsubstituted alkenyl group having 1 to 28 carbon atoms, a substituted or unsubstituted cycloalkyl group having from 3 to 28 carbon atoms, a substituted or unsubstituted acyloxy group having from 2 to 25 carbon atoms, a substituted or unsubstituted alkoxy group having from 1 to 28 carbon atoms, a substituted or unsubstituted aryl group having from 6 to 33 carbon atoms, a substituted or unsubstituted heterocyclic ring having from 1 to 28 carbon atoms and one or more hetero atoms, an alkyl, cycloalkyl, alkenyl, alkoxyalkyl, aryl, or phenoxy group, connecting to a substituted or unsubstituted aryl group, having 6 to 33 carbon atoms, or an alkyl, cycloalkyl, alkoxyalkyl, aryl, or phenoxy group connecting to a substituted or unsubstituted heterocyclic ring containing two or more hetero atoms;

said R_1 , R_2 , and R_3 may further combine with each other to form a 5-, 6- or 7-membered ring; with the proviso that

said accelerator compound is present in an amount between 10^{-8} and 10^{-3} moles/L; and

said developer prebath and developer bath do not contain any iron(III) ion complex salt having bleaching activity or any nucleating agent capable of chemically fogging a negative-type silver halide emulsion.